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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional)  0113715.00134US1
	Application Number 10/624,445-Conf. #6446	Filed July 22, 2003
	First Named Inventor Alan COX	
	Art Unit 2449	Examiner A. B. Patel
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <div style="display: flex; justify-content: space-between; align-items: flex-start;"><div style="width: 60%;"><p><input type="checkbox"/> applicant /inventor.</p><p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p><p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>42,478</u></p><p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p></div><div style="width: 35%; text-align: center;"><p>_____ /Ronald R. Demsher/ Signature</p><p>_____ Ronald R. Demsher Typed or printed name</p><p>_____ (617) 526-6000 Telephone number</p><p>_____ June 22, 2010 Date</p></div></div> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>		
<div style="display: flex; align-items: center;"><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</div>		

## SUMMARY OF PROSECUTION HISTORY

On March 14, 2005, the Examiner issued a non-final Office Action rejecting claims 1-13 under 35 U.S.C. §103(a) as unpatentable over Dieterman (U.S. Patent No. 6,393,464) in view of Lu (US2002/0107950). In response, the Applicant submitted an amendment on June 14, 2005 amending claims 2, 3, 6, 8, 11-13, canceling claims 1, 4, 5, 7, 9 and 10, and adding new claims 14-17.

On August 3, 2005, the Examiner issued a Final Office Action rejecting claims 1, 3, 6, 8 and 11-17 under 35 U.S.C. §103(a) as unpatentable over Dieterman in view of Lu. The Applicant submitted a response on October 3, 2005 amending claims 2, 3 and 8, canceling claims 6 and 11-17 and adding new claims 18-28.

On October 25, 2005, the Examiner issued an Advisory Action maintaining the rejections and refusing to enter the October 3, 2005 amendments. The Applicant resubmitted the October 3, 2005 amendments along with a Request for Continued Examination (RCE).

On March 27, 2006, the Examiner issued a non-final Office Action rejecting claims 2, 3, 8 and 18-30 under 35 U.S.C. §103(a) as unpatentable over Lu in view of Bulfer (US2006/0036701) and in further view of Sherman (US2002/0194177). The Applicant submitted a response traversing the rejections on July 26, 2006, without amending claims.

On October 13, 2006, the Examiner issued a Final Office Action maintaining the earlier rejections. The Applicant requested and participated in an Examiners interview on December 12, 2006, and submitted a response on December 13, 2006 amending claims 18 and 26 based on the Interview.

On January 22, 2007, the Examiner issued an Advisory Action maintaining the prior rejections and refusing to enter the December 13, 2006 amendment. The Applicant resubmitted the amendment on February 2, 2007 along with an RCE.

On May 1, 2007, the Examiner issued a non-final Office Action rejecting claims 2, 3, 8 and 18-30 under 35 U.S.C §112, first paragraph, and under 35 U.S.C §102(e) as anticipated by Mastrianni. The Applicant responded on August 1, 2007 by amending claims 18 and 26.

On October 26, 2007, the Examiner issued a Final Office Action rejecting claims 2, 3, 8 and 18-30 under 35 U.S.C. §103(a) as unpatentable over Lu in view of Bulfer (US2006/0036701) and in further view of Sherman (US2002/0194177). On October 31, 2007 the Applicant submitted a response requesting clarification of the pending Office Action, along with an RCE.

On January 16, 2008, the Examiner issued a non-final Office Action reiterating the prior rejections and providing an overview of the prosecution history. On April 1, 2008, the Applicant participated in an Examiner's interview to discuss aspects of the pending Office Action for which the Applicant requested clarification. On April 17, 2008, the Applicant submitted a response requesting reconsideration.

On July 28, 2008, the Examiner issued a Final Office Action maintaining the prior rejections. On September 29, 2008, the Applicant responded to the Final Office Action and

requested reconsideration. In response, the Examiner issued a non-final Office Action on October 16, 2008, rejecting claims 2, 3, 8 and 18-30 as unpatentable under 35 U.S.C. §103(a) over Lu in view of Hickey (2002/0087686). The Applicant responded to this Office Action on January 16, 2009 by traversing the rejections.

On March 11, 2009, the Examiner issued a Final Office Action maintaining the prior rejections. On April 15, 2009, the Applicant submitted a response amending claims 18 and 26. On April 23, 2009, the Examiner issued an Advisory Action maintaining the rejections and refusing to enter the April 15, 2009 amendment. On June 11, 2009, the Applicant resubmitted the April 15, 2009 amendment in response to the Advisory action, along with an RCE.

On August 3, 2009, the Examiner issued a non-final Office Action rejecting claims 2, 3 and 19-24 under 35 U.S.C. 112, and claims 2, 3, 8 and 18-30 under 35 U.S.C. §103(a) as unpatentable over Lu in view of Hickey. On October 21, 2010 the Applicant responded by amending claims 18 and 26.

On February 22, 2010, the Examiner issued a Final Office Action maintaining the rejections under 35 U.S.C §103(a). On April 14, 2010, the Applicant submitted a response to the Final Office Action presenting arguments to the rejections, without amending claims. On April 28, 2010, the Examiner issued an Advisory Action maintaining the prior rejections.

## THE CURRENT STATE OF PROSECUTION

The current state of claim 18 is as follows:

18. A method for operating an electronic messaging system comprising:
  - routing an electronic message intended for a first user to at least two human approvers, wherein each of the at least two human approvers maintains an independent copy of the routed electronic message, and wherein each of the at least two human approvers can approve or reject the electronic message prior to the electronic message being routed to the first user;
  - presenting the electronic message on a display to at least one of the approvers for approval or rejection;
  - determining whether the electronic message is approved or rejected by applying a predetermined policy toward approval or rejection actions by the at least one of the approvers presented with the electronic message;
  - routing the electronic message to the first user if the electronic message is approved; and
  - once the electronic message is approved or rejected by one approver, notifying the at least one other approver of a changed status for the electronic message wherein the notifying includes providing to the at least one other approver an indicator to be associated with the other approver's copy of the electronic message, the indicator characterizing the changed status

The Applicant submits that neither Hickey nor Lu, alone or in combination, teaches or suggests one approver notifying another approver of the changed status of an electronic message, where each approver maintains an independent copy of the electronic message.

The Examiner states that Lu fails to teach this notifying limitation, and the Applicant submits that Hickey also fails to teach such notification at least because Hickey provides no status indicators associated with independent copies of an electronic message as claimed.

The Examiner relies on Hickey for teaching, “. . . *notifying the at least one other approver of a changed status for the electronic message wherein the notifying includes providing to the at least one other approver an indicator to be associated with the other approver’s copy of the electronic message . . .*” Hickey describes status indicators (e.g., status indicators 57yxz described in paragraph [0043]), but those status indicators are not associated with another approver’s copy of the electronic message as the rejected claims require. Lu does not supply that which is missing from Hickey, because although Lu describes that an electronic message may be directed to one or more supervisory recipients, Lu fails to teach or suggest the “notification” limitation of the rejected claims. The Examiner notes this deficiency on page 8 of the February 22, 2010 Office Action.

The amendments included in the Response dated October 21, 2009 add the requirement that (i) the approvers maintain independent copies of the message and (ii) actions taken by one approver with respect to that approver’s copy of the message are conveyed to the other approver by associating an indicator with the other approver’s copy of the message.

As the Examiner points out, Hickey describes an automated directing of electronic communications to a selected mailbox other than the default inbox of the group electronic mailbox. As described in paragraph [0040] of Hickey, each member of a group can specify a match criteria to define how an electronic communication is handled. Sending the communication to a specific mailbox is just one of several examples Hickey describes. The match criteria allows users to sort and otherwise dispose of incoming communications.

A key point is that Hickey describes electronic communications as unique entities, without reliance on copies, whereas the independent claims 18 and 26 require maintaining independent copies. Hickey describes routing and/or operating on incoming electronic communications, and associating status information with the communication based on those actions. Hickey, however, does not teach or suggest directing multiple, independent copies of a particular communication to different users’ mailboxes. Doing so would go against the teachings of Hickey because Hickey relies on group mailboxes when two or more users need to view the same communication. Hickey repeatedly describes the benefits of such shared communication, and the drawbacks of independent copies of communications in separate mailboxes. For example:

“A group electronic mail (e-mail) mailbox is provided to enable multiple users to work collaboratively and simultaneously with one or more electronic communications received in the group e-mail mailbox. The group e-mail mailbox provides tools that allow members of a group to access and manipulate the received electronic communications.” (Abstract).

“The copies of the e-mail message in each member’s box exist independently and are not linked. Electronic mailboxes are configured for use by only one user at a time. Thus, it is difficult for members of the group to coordinate their actions. For example, it can be difficult to establish whether any member of the group has responded to a particular received electronic communication without individually contacting each member of the group. It can also be difficult to obtain other status information such as how, when, and by whom in the group the communication is being processed. Information that should be made available in a timely manner to each group member may not be shared at all or at least not simultaneously.” (paragraph [0005]).

“Consequently, it can be difficult for different members of a group to work collaboratively without frequent telephonic or electronic communications across the whole group. Moreover, the lack of simultaneous sharing of all the electronic communications intended for use by the whole group can severely impair an efficient and coordinated functioning of a group.” (paragraph [0008]).

“In the present invention, a system and method is provided for multiple users to concurrently share one or more electronic communications. The electronic communications reside in electronic mailbox that is accessible by members of the group. When an authorized member of the group takes an action with regard to the electronic communication, other members of the group can see what has been done.” (paragraph [0016]).

“Once the electronic communication is stored in the group electronic mailbox, any member of the group can view the stored electronic communication and any member of the group having an appropriate permission attribute can determine an appropriate response or an action responsive to the electronic communication. For example, an individual member of the group can select actions from a set of response tools for performing desired functions.” (paragraph [0020]).

This theme is repeated throughout Hickey. The group mailboxes of Hickey remove the motivation for duplicating incoming messages. Hickey clearly teaches away from creating independent copies of electronic communications as required by the rejected claims.

Figure 7 of Hickey further demonstrates the above-described reliance on a group mailbox when an e-mail is directed to multiple users, rather than generating copies of the e-mail. Reference numbers 236, 244, 246, 249 and 240 describe a path associated with an e-mail destined for multiple users. When a comparison (reference 236) determines a match to a criteria template, notification recipients are determined (reference 244) and the corresponding recipients are notified (references 246 and 248). The associated e-mail is then delivered to a group mailbox (reference 240 through tab A). The notified members of the group can then access the e-mail through the group mailbox, and perform various acts on the e-mail (reference 265).

The Examiner further cites the following text from Hickey regarding the “notification” claim limitation in the rejected claims:

From Hickey paragraph [0015]: “It is still a further aspect of the invention to provide an automatic method for updating and notifying members or users of a group of any changes in status information of received electronic communications, the received electronic communications are being continually operated on by multiple members or users of the group to cause changes in their statuses.”

From Hickey paragraph [0043]: “In response to acts by one member of group 22A1 that cause a status change, a signal is transmitted to update the associated status indicator 57A1 for any other group member viewing the status indicator 57A11.”

The Applicant notes that neither of these descriptions satisfy the requirement of “. . . wherein the notifying includes providing to the at least one other approver an indicator to be associated with the other approver’s copy of the electronic message . . .” (emphasis added). The status changes referred to in these paragraphs concern modifications of one particular received message, and do not relate a change made to one approver’s copy of an electronic message to

another approver's copy of the same message. In other words, Hickey teaches that when any one of several users modifies a received electronic communication, the status of that communication is updated so that other users viewing the communication will be notified of the modification.

The messages of Hickey are unique – no copies exist that need to be coordinated. This concept is described throughout Hickey. Paragraph [0043] describes a “. . . status indicator 57yxz for each of the one or more electronic communications 53yx . . .” (emphasis added). The ‘z’ index of the status indicator represents particular types of modification status, such as ‘new’, ‘read’, ‘answered’, etc., as shown in Hickey Figure 6. This figure clearly illustrates that each status indicator 57yxz corresponds to one and only one message, which all users in a particular group can view. When one user modifies an electronic communication, the status indicator changes so that other users are notified of the change when the other users view the electronic communication. For example, the status indicator of the first communication in Figure 6 changes from ‘New’ to ‘Read’ when any of the users reads that communication. Subsequent users are notified of this status change when they view the communication along with its associated status indicator.

Finally, on page 10 of the February 22, 2010 Office Action, the Examiner states, “The reasons why Hickey came up with this system and method is stated in para. [0007], ‘some group members may be deprived of information regarding the received e-mail message and the actions taken by the other group members in connection with the message. In addition, there is limited control on the flow, distribution and processing of the information intended to be shared among the members of group 22.’ ”

In the cited text, Hickey describes disadvantages associated with prior art e-mail systems that create copies of an incoming e-mail in separate mailboxes (i.e., “An e-mail 21 addressed to group 22 is received in the respective e-mail mailbox 201, 202 and 203 for the users U1, U2, and U3” paragraph [0007]).

Hickey's solution to the disadvantage cited by the Examiner above is to create group mailboxes rather than instantiate copies of the e-mail in separate mailboxes. The Applicant's claims, on the other hand, recite independent copies of the electronic message and relates those copies to one another through an indicator. Hickey is clearly teaching away from the Applicant's claimed subject matter.

For the foregoing reasons, independent claims 18 and 26 should be allowable. Dependent claims 2, 3, 8, 19-25 and 27-30 should also be allowable as depending from allowable base claims.